

matter. The outstanding rejection, set out in paragraph 2 of the Advisory Action of May 19, 1994 is a 35 USC 112, first paragraph rejection on non-enablement.

At the bottom of page 3 of the Advisory Action, it is stated "a protocol is insufficient to demonstrate enablement." As a general statement, that is plainly untrue. To be submitted in the near future are the instruction booklets for applicant's kits RPN 1688/9 and RPN 1690. The protocols are set out on the back pages. Applicant makes regular sales of these kits to users, who are, in fact, enabled by the protocols to perform the methods.

It is thus apparent that protocols can be and are enabling. To determine whether a particular protocol is enabling or not, one needs to look at the detail.

Applicant has previously submitted that Example 7 provides an enabling disclosure to support claim 14. The Examiner is respectfully invited to compare Example 7 of the subject application with the protocol in the booklet RPN 1688/9. It is believed beyond argument that the protocol in the booklet is enabling (the date of the booklet is immaterial in this connection). Although there are a number of differences of detail between the protocol in the booklet and that in Example 7, both involve essentially alkaline lysis with three fmp (fast magnetic purification) precipitation steps: 1) bacteria; 2) cell debris (protein, DNA, RNA, etc.); and 3) plasmid DNA. Thus, the protocol of Example 7 is enabling and provides support for claim 14.

New claim 21 recites a protocol which is closely based on Example 5 of the subject application. If the Examiner will compare Example 5 with the protocol in the booklet RPN 1690, it will be seen that the two are almost identical. The only differences are:

a) The volumes used in step 2 (of the RPN 1690 booklet) are half those used in Example 5, but the ratios are the same; and

b) The chaotrope used in step 4 (of RPN 1690) is sodium iodide, where perchlorate is used in Example 5, but this difference is not significant in terms of getting the method to work.

It is clear that the protocol of RPN 1690 is enabling. Thus, the protocol of Example 5 is enabling also and provides support for claim 21.


No further issues remaining, allowance of this application is respectfully requested.

If the Examiner has any comments or proposals for expediting prosecution, he is invited to contact undersigned at the telephone number below.

Respectfully submitted,

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October 4, 1994